

**REMARKS**

In accordance with the foregoing, claims 1, 12, 14, 15, 17 and 20 have been amended, claim 11 has been cancelled without prejudice or disclaimer, and claims 1-22 are pending and under consideration. Support for the amendments to the claims can be found, for example, at paragraphs [0040] and [0050] of the specification. No new matter is presented in this Amendment.

**REJECTIONS UNDER 35 U.S.C. §101:**

Claims 1-16 are rejected under 35 U.S.C. §101 because the claims are “directed to a recording medium storing nonfunctional descriptive material.” In maintaining the rejections of claims 1-16 under 35 U.S.C. §101, the Examiner states: “In response to the Applicant argument, the amended claims still [do] not overcome the rejection under 35 U.S.C. §101 because the reproduction apparatus is not performing the functions of any of the limitations recited on the claims but the storage medium and the still image data clip are. The storage medium and the still image clip can still be interpreted as any medium that includes the information cited on the claims. Therefore the rejection is maintained.”

In response to the Examiner’s argument regarding claims 1-16, it is respectfully submitted that the Examiner is unreasonably exaggerating the scope of claims 1-16. Claim 1 recites the features of: “[a]n information storage medium storing at least one still image data clip to be executed by a reproducing apparatus...” “...still image clip information including information used by the reproducing apparatus to determine a position and attributes of still images in the at least one still image data file...,” and “still image sequence information including information used by the reproducing apparatus to determine presentation modes and a presentation time.” Thus, claim 1 recites three separate features which define how the information storage medium functions and interrelates with the reproducing apparatus. Therefore, the Examiner incorrectly argues that “the reproduction apparatus is not performing the functions of any of the limitations recited on the claims,” because the reproduction apparatus is: (1) executing the still image data clip by (2) using the still image clip information, and (3) the still image sequence information, to correctly perform this execution.

Contrary to the Examiner’s arguments, the storage medium and the still image clip cannot reasonably be interpreted “as any medium that includes the information cited on the claims.” As stated in MPEP §2111.01, “[d]uring examination, the claims must be interpreted as broadly as their terms reasonably allow.” The Examiner has taken an unreasonable position in arguing that any medium can perform the functions recited by the information storage medium

of claim 1.

Furthermore, neither the MPEP nor the courts have implemented a *per se* rule barring claim language reciting “an information storage medium,” and in fact, many claims which do not recite a “computer-readable medium” have been upheld as statutory subject matter in compliance with 35 U.S.C. §101. For example, claim 1 of In re Lowry, 32 F.3d at 1581; 32 USPQ2d at 1033, is drawn to a “memory for storing data for access by an application program being executed on a data processing system.” Claim 1 does not recite the word “computer,” the phrase “computer-readable,” or the phrase “computer-readable medium.” Furthermore, the memory recited in claim 1 could theoretically be embodied as a human memory, and yet the Federal Circuit still upheld claim 1 as statutory subject matter under 35 U.S.C. §101. Similarly, in this case, the Examiner should not reject claims 1-16 simply because claims 1-16 do not recite the phrase “a computer-readable medium.” There is no legal basis to reject claims 1-16 under 35 U.S.C. §101 simply because claims 1-16 do not recite the phrase “computer-readable medium.”

Thus, it is respectfully submitted that the rejections of claims 1-16 under 35 U.S.C. §101 should be withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. §103:**

Claims 1-10 and 17-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato (U.S. Patent Publication 2002/0145702) (hereinafter “Kato”) in view of Okada (U.S. Patent Publication 2003/0165329) (hereinafter “Okada”).

#### **Claim 1**

Claim 1 has been amended to incorporate the limitations of claim 11. Before this amendment, claim 11 was the first claim in the instant application to recite the feature of a browsable slide show mode. The Examiner rejected claim 11 at pages 7-8 of the most recent Office Action, arguing that “regarding claim 11, the above combination fail to show a presentation mode for the at least one still image data file is one of a slide show mode in which the presentation time for the at least one still image data file is synchronized with the presentation time for a corresponding audio data file and a browsable slide show mode in which the presentation time for the at least one still image data file is not synchronized with the presentation time for a corresponding audio data file and a presentation order of the at least one still image data file is changeable when the at least one still image data file is presented. In the same field of endeavor, Gadre (U.S. PG PUB 2003/0152371 A1) discloses a presentation mode for the at least one still image data file is one of a slide show mode in which the presentation

time for the at least one still image data file is synchronized with the presentation time for a corresponding audio data file and a browsable slide show mode in which the presentation time for the at least one still image data file is not synchronized with the presentation time for a corresponding audio data file and a presentation order of the at least one still image data file is changeable when the at least one still image data file is presented (see fig. 1 paragraphs [0009] and [0032]). Therefore in light of the teaching in Gadre, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the proposed combination by controlling presentation of still images in order to present the images according to user preferences.”

However, Gadre does not disclose “wherein one of the presentation modes comprises a browsable slide show mode,” as recited by claim 1. Paragraph [0009] of Gadre discloses the following:

“Still images are pre-loaded into the player’s memory before the audio is played or between audio tracks where a mute is acceptable. This allows the images to be presented either as a slide show or browsable by the user (emphasis added).”

Paragraph [0009] of Gadre thus discloses still images that may be presented as either a slide show, or in a format which is browsable by the user. However, paragraph [0009] does not disclose a presentation mode which is a combination of a slide show and a browsable format, i.e., a browsable slide show, as recited by claim 1. Similarly, paragraph [0032] discloses images which are presented as “either” a slide show “or” browsable by the user, but does not disclose a browsable slide show combination format. Moreover, nothing else in the specification or figures of Gadre suggests the feature of a browsable slide show presentation mode, as recited by claim 1.

In addition, Gadre does not disclose a slide show mode in which the presentation time for the at least one still image data file is synchronized with the presentation time for a corresponding audio data file. As discussed above, Gadre discloses that images may be displayed in a slide show format. However, Gadre is silent as to whether, when the images are displayed in the slide show format, the presentation time for an image data file is synchronized with a corresponding audio data file. For example, if an image data file is synchronized with an audio file, then if the image file is fast-forwarded, the audio file will be similarly fast-forwarded. Or, if the image file is reversed (rewound), the audio data file will remain synchronized with the image file and will thus reverse as well. Gadre, however, is silent as to whether the image file is synchronized with a corresponding audio file.

Thus, it is respectfully submitted that the rejection of claim 1 should be withdrawn for at least these reasons.

#### **Claims 2-10**

Claims 2-10 depend on claim 1. Accordingly, it is respectfully submitted that the rejection of claims 2-10 should be withdrawn for substantially the same reasons that the rejection of claim 1 should be withdrawn.

#### **Claim 17**

Claim 17 has been amended to incorporate the limitations of claim 11. As explained above with reference to claim 1, paragraphs [0009] and [0032] of Gadre disclose still images which are presented as “either” a slide show “or” browsable by the user, but do not disclose a browsable slide show presentation mode, as recited by claim 17. In addition, Gadre does not disclose a slide show mode in which the presentation time for the at least one still image data file is synchronized with the presentation time for a corresponding audio data file, as discussed above. Further, neither Kato nor Okada disclose the feature of a browsable slide show presentation mode, as recited by claim 17. Thus, it is respectfully submitted that the rejection of claim 17 should be withdrawn for at least these reasons.

#### **Claims 18-19**

Claims 18-19 depend on claim 17. Accordingly, it is respectfully submitted that the rejections of claims 18-19 should be withdrawn for substantially the same reasons that the rejection of claim 17 should be withdrawn.

#### **Claim 20**

Claim 20 has been amended to incorporate the limitations of claim 11. As explained above with reference to claim 1, paragraphs [0009] and [0032] of Gadre disclose still images which are presented as “either” a slide show “or” browsable by the user, but do not disclose a browsable slide show presentation mode, as recited by claim 20. In addition, Gadre does not disclose a slide show mode in which the presentation time for the at least one still image data file is synchronized with the presentation time for a corresponding audio data file, as discussed above. Further, neither Kato nor Okada disclose the feature of a browsable slide show presentation mode, as recited by claim 20.

Thus, it is respectfully submitted that the rejection of claim 20 should be withdrawn for at least these reasons.

**Claims 21-22**

Claims 21-22 depend on claim 20. Accordingly, it is respectfully submitted that the rejections of claims 21-22 should be withdrawn for substantially the same reasons that the rejection of claim 20 should be withdrawn.

**Claims 11-16**

Claims 11-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato (U.S. Patent Publication 2002/0145702) in view of Okada (U.S. Patent Publication 2003/0165329) and further in view of Gadre (U.S. Patent Publication 2003/0152371). Claim 11 has been cancelled without prejudice or disclaimer, and the rejection of claim 11 is thus moot.

Claims 12-16 depend on claim 1. Accordingly, it is respectfully submitted that the rejections of claims 12-16 should be withdrawn for substantially the same reasons that the rejection of claim 1 should be withdrawn.

Based on the foregoing, this rejection is respectfully requested to be withdrawn.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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